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Paper No. 17

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In re Application of: Umesh Bhavsar )  
Application No.: 09/581,046 ) **DECISION VACATING PREVIOUS**  
Filed: June 8, 2000 ) **DECISION ON PETITION UNDER**  
For: SWITCHED CONNECTION ) **37 C.F.R. § 1.181 TO WITHDRAW**  
SYSTEM WITH ACCESS TO ITS ) **HOLDING OF ABANDONMENT-**  
OWN RESOURCES VIA THE )  
INTERNET )

This is a decision on the petition filed December 22, 2003 under 37 CFR § 1.181 to a withdraw the holding of abandonment of the above-identified application.

On January 13, 2004 a decision granting the petition and withdrawing the holding of abandonment was issued. *A review of the facts in the case reveals that the decision was in error.*

The original decision mailed January 13, 2004 is **VACATED**. The petition to withdraw the holding of abandonment is **DISMISSED**. The application has been restored to abandoned status.

**RECENT CASE HISTORY**

May 9, 2003 - Non-Final Rejection (Paper No. 9) mailed. Six (6) month statutory period for timely response commences.

November 10, 2003 - Request for Continuing Examination (RCE) filed with petition for extension of time, fee transmittal and a substitute specification.

December 3, 2003 - Notice of abandonment mailed. The notice indicates that as prosecution is not closed the RCE is improper and is treated as a submission in response to the Office action. However, since there was no response to the Office action included

December 22, 2003 - Petition to withdraw abandonment filed

January 13, 2004 - Decision granting petition mailed.

### **BASIS OF OPINION**

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

#### **35 U.S.C. 133 Time for prosecuting application**

Upon failure of the applicant to prosecute the application *within six months* after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

#### **37 C.F.R. § 1.114 Request for continued examination.**

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§1.113), a notice of allowance (§1.311), or an action that otherwise closes prosecution in the application.

#### **MPEP 706.07(h) Request for Continued Examination (RCE) Practice**

##### **A. Treatment of Improper RCE**

If one or more conditions for filing an RCE have not been satisfied, applicant will be so notified. Generally, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, will be mailed to applicant. *An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.*

If an examiner discovers that an improper RCE has been forwarded to the examiner in error, the application should be immediately returned to a head supervisory legal instruments examiner (HSLIE) within the TC.

##### **1. Prosecution Is Not Closed**

If prosecution in the application is not closed, applicant will be notified of the improper RCE and any amendment/reply will be entered. Thereafter, the application will be forwarded to the examiner for consideration of the amendment/reply under 37 CFR 1.111.

### DECISION

In support of the petition, Petitioner provided a copy of (1) a substitute specification which included a marked up version of the claims as amended in the preliminary amendment of June 8, 2002; (2) an RCE transmittal including authorization to charge RCE and extension of time fees to Deposit Account No. 03-1952, (3) a petition for extension of time, (4) a fee transmittal sheet, and (5) a post card with a PTO stamp indicating receipt at the USPTO on November 10, 2003 of a submission in this application.

The post card has a typed listing of "Papers enclosed" corresponding to items 1-4 of the preceding paragraph. In addition, the copy of the post card presented with this petition has a handwritten notation of an "Amendment" as a fifth paper enclosed.

*The submission enclosed with the petition does not contain an amendment.* The reference to an Amendment in the previous decision was error on the part of the undersigned who mistakenly believed the marked up version of the claims presented in the preliminary amendment of June 8, 2000 to be a new claim amendment. Furthermore, there was no response to any of the art based rejections of the May 9, 2003 Office action.

Applicant's petition confirms this conclusion as it makes no mention of the submission of an amendment and no representation that any amendment was filed. It states:

A copy of the RCE Transmittal, fee transmittal, extension of time transmittal, substitute specification, marked-up specifications, and stamped return postcard dated November 10, 2003 is attached hereto evidencing that the response was timely filed on November 10, 2003.

Petitioner has established that a response was filed on November 10, 2003 with the authorization to charge the requisite fee for a three-month extension of time necessary for the response to be considered timely. However, as correctly noted by the Examiner in the Notice of abandonment the papers filed were not responsive to the Office action and therefore the application was properly abandoned.

The petition is **DISMISSED**. If the petitioner desires further review of this Decision, applicant should consider filing a Request for Reconsideration within 2 months of the mailing date of this Decision.

The application file is being forwarded to the Files Repository.



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